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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,635	12/31/2001	Ronald L. Edens	17,698	5833
23556	7590	08/11/2004	EXAMINER	
KIMBERLY-CLARK WORLDWIDE, INC. 401 NORTH LAKE STREET NEENAH, WI 54956			REICHLE, KARIN M	
			ART UNIT	PAPER NUMBER
			3761	

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/036,635

Applicant(s)

EDENS ET AL.

Examiner

Karin M. Reichle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 May 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2-20-04, 5/25/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5-3-04 has been entered.

### ***Specification***

### ***Drawings***

2. The drawings were received on 5-3-04. These drawings are approved by the Examiner. Note any USPTO-948 which accompanies this action.

### ***Claim Objections***

3. Claims 1-33 are objected to because of the following informalities: in claims 1, 11, 18 and 26, line 7 (claims 1 and 18) or line 8 (claims 11 and 26), "facing" should be --faceable--. Appropriate correction is required.

***Claim Language Interpretation***

4. It is noted that while “labial pad” is defined on page 4, lines 18-20 that the claims are drawn to an “absorbent article”. “Vestibule” is defined as set forth on page 4, lines 20-24 and the sentence bridging pages 4-5. “Disposition...vestibule” is defined as set forth on page 4, lines 27-29, and page 5, lines 6-11 and 22-24. The various directional terms used in the claims are defined as set forth on page 5, lines 12-19. “Generally circular geometry” and “generally circular periphery” are defined as set forth on page 5, lines 27-32, i.e. the body facing surface of the absorbent has a generally circular shape and has a radius which extends from a point located in the center of such face to a point on the periphery. “Z-axis thickness” is interpreted as set forth on page 7, lines 21-22 and Figure 5, i.e. the thickness along an axis generally parallel to the vertical plane Z-Z. It is noted that the thickness is not required to be taken along the principal longitudinal axis, i.e. the principal z-axis, or that the z-axis thickness of the absorbent be uniform. “Notch” is defined as set forth on page 13, lines 15-16 and page 15, lines 5-6.

***Claim Rejections - 35 USC § 102***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1-6, 8-15, 17-23, 25-31 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by P & G, PCT ‘609.

The PG ‘609 reference, see Figures, teaches an absorbent article 20 comprising an absorbent 22(see page 9, lines 11-12) and 24(see page 17, lines 29-30), having superabsorbent, see page 15, lines 1-16, a fluid permeable cover, see page 18, lines 23-

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29, and a liquid impermeable baffle, see page 17, last three lines. The absorbent, 22 and 24, is situated vertically along a z-axis between the lower surface of the cover and the upper body faceable surface of the baffle, see, e.g., portions already cited and Figure 4. The absorbent article appears to be configured for disposition within the vestibule as claimed in claims 1, 11, 18 and 26, see claim interpretation section supra, and PG '609, i.e. definition of "interlabial absorbent device" bridging pages 6-7 and the first full paragraph on page 8. The article has a substantially circular geometry, see claim interpretation section supra and PG '609 at page 10, lines 6-8 and page 16, lines 18-19, i.e. as seen from above the body facing surface '609 contemplates an embodiment in which the absorbent has a substantially circular geometry and periphery as well as a radius.

Since the length of the portions 24 can be greater than that of portion 22, see Figures again, page 8, lines 15-19, page 10, lines 12-15, page 16, lines 19-24, page 20, third full paragraph, at least one notch is situated in the periphery at axis L or x which extends through the entire z-axis thickness and extends inward from the periphery to a depth which depth includes a depth of no less than 2, 3, 4, 5, 10, 15 or 20 mm but no greater than about 30 mm. The notch also includes a width, i.e. see width of 22 along T or y and page 8, lines 19-24, which is no greater than about 30 mm. The absorbent is thicker than about 1 mm but no greater than 10mm, see page 8, lines 25-27 and page 16, lines 29 et seq, and has a basis weight of no less than 110 or 150 grams per meter squared, see page 17, lines 29-30, page 12, first full paragraph (and thereby '642 at col. 16, lines 37-42 and '414 at col. 17, lines 23-24) and page 15, second and third full

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paragraphs, i.e. all the materials of the absorbent include basis weights which are greater than those claimed.

The dimensions disclosed by '609 appear to be sufficient to allow the spacing from the perineum or clitoris as claimed in claims 3, 5, 13, 15, 20, 22, 28 and 30, see '609 at portions cited supra. In any case or the second case, with regard to the functions, properties and capabilities set forth in claims 1, 11, 18 and 26, i.e. "being configured...vestibule", and 3, 5, 13, 15, 20, 22, 28 and 30, see the claim interpretation section supra above and note that the PG device includes the claimed structure. Therefore, there is sufficient factual basis for one to conclude that the functions, properties and capabilities of such claimed structure would also be inherent in the same structure of PG. See MPEP 2112.01. In still another or third case, Applicant discloses the radius ranging from no less than about 15 up to no more than 50 mm, the thickness of less than about 10 mm and the notch having a width and a depth no greater than 30 mm. The PG reference discloses, at the portions cited above, dimensions, e.g. radii (lengths and widths of portions 22 and 24), commensurate to those disclosed by Applicant. Therefore, again there is sufficient factual evidence to conclude that the properties, functions and capabilities of such dimensions would also be inherent in the same dimensions of PG. See MPEP 2112.01. It is noted with regard to claims 4, 14, 21 and 29, the claim does not require all the widths or the largest width being no greater than 30 mm.

***Claim Rejections - 35 USC § 103***

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 7, 16, 24 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over PG '609 in view of Lichstein '197.

Applicants claim the cover encloses the absorbent, and a backsheet or baffle while PG '609 teaches a topsheet and backsheet on opposite sides of the absorbent. See portions of '609 cited supra. Such '609 configuration provides a liquid pervious surface on one side of the absorbent and a liquid impervious surface on the opposite side of the absorbent. The Lichstein reference is cited to show an interlabial pad which includes a topsheet which encloses, i.e. encases, the labial device absorbent as well as a backsheet. This configuration also provides a liquid pervious surface on one side of the absorbent and a liquid impervious surface on the opposite side of the absorbent. To make the topsheet and backsheet on opposites sides of the absorbent of PG '609 a topsheet which encloses the labial device absorbent and a backsheet as taught by Lichstein would be obvious, see *In re Siebentritt*, 54 CCPA 1083(two equivalents are interchangeable for their desired function, express suggestion of desirability of substitutions not need to render such substitution obvious).

***Double Patenting***

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed.

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Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1-33 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of copending Application No. 10/036,990(2002/0193769A1) in view of PG '609. Although the conflicting claims are not identical, they are not patentably distinct from each other because since the instant application and the other application were filed on the same day, the one way *In re Vogel* test applies, i.e. are the claims of the instant application obvious in view of the claims of the other application? The answer is yes. The claims of the '990 application include all the structure claimed in the instant application except for 1) a circular geometry and periphery, 2) more limited ranges of dimensions, e.g. basis weights, and 3) broader ranges of dimension, e.g. the lower limit of the minimum width of the absorbent. With regard to 1), the '990 application claims axes and a periphery with longitudinal sides and transverse end areas. See PG '609 at page 16, lines 13-19, i.e. a circular geometry and periphery is exchangeable for a axes and a geometry and periphery defined by longitudinal sides and transverse end areas, e.g. a rectangle, a trapezoid. To make the axes and longitudinal sides and transverse end areas of '990 a circular geometry and periphery instead would be obvious to one of ordinary skill in the art in view of the interchangeability as taught by PG '609. With regard to 3) the instant claims are



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broader. Once applicants have received a patent for a species or a more specific embodiment, they are not entitled to a patent for the generic or broader invention. This is because the more specific anticipates the broader. Therefore the claims are not patentably distinct. See *In re Goodman*, supra. With regard to 2), where the general conditions of a claim are disclosed in the prior art, i.e. an absorbent has a basis weight and a notch which permits disposition with the vestibule and maintenance of a spaced relationship from the clitoris or perineum, it is not inventive to discover the optimum or workable ranges, i.e. the basis weight, by routine experimentation, see *In re Allen et al*, 105 USPQ 233.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Response to Arguments***

11. Applicant's remarks with regard to the formalities have been noted but are either deemed moot in that the discussed issues have not been reraised or are deemed not persuasive for the reasons set forth supra. Applicant's remarks with regard to the prior art rejections are deemed not persuasive because such are narrower in scope than the claim language and the teachings of the prior art, e.g. the flexible extensions 24 which can be attached to or monolithically formed with 22 can be absorbent and the cover can cover both 22 and 24, see last full paragraph on page 18. The absorbent 22 and 24 as seen in Figures 1 and 2 in the case where the portion 22 is shorter in length than 24, see portions of '609 discussed supra, would include a notch contrary to Applicant's arguments. Applicant's remarks with regard to the double patenting rejections and the

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terminal disclaimers have been noted. However, the language of paragraph 1 after the subheading "Provisional Terminal Disclaimer", i.e. "In the event...", is still not deemed proper by the reviewing paralegal since if the application is a good reference it should not matter which issues first, the terminal disclaimer must disclaim unconditionally, no provisional language should be included.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Sneider reference teaches a circular absorbent pad with dimensions similar to those claimed.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karin M. Reichle whose telephone number is (703) 308-2617. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Calvert can be reached on (703) 308-1025. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Primary Examiner  
Art Unit 3761

KMR  
August 3, 2004